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Steven J Harris

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. HARRIS, MICHAEL C. HEBBRON, and
IAN M. STURLAND

Appeal 2009-003895
Application 10/529,227
Technology Center 1700

Before CATHERINE Q. TIMM, MICHAEL P. COLAIANNI, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

Appellants request rehearing of our Decision of September 14, 2009. The focus of the appeal and, therefore, our Decision was on the question of whether Appellants had established that the Examiner reversibly erred in finding a reason to form Kim's plurality of tracks so as to have U-shaped

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

bends as taught by Ansuini and further in finding that the references do not “teach way” from forming such U-shaped bends (Decision 4).

Appellants now contend that our Finding of Fact 8 (FF 8) contained errors, that the evidence (Ansuini and Kim, and specifically, FF 5 and 8) does not support our finding that the references do not teach away, and that we misapprehended the “space saving” teaching of Ansuini. We disagree for the reasons below.

FF 8 reads as follows:

The Examiner finds, and Appellants do not dispute, that Ansuini describes corrosive tracks 66 and 86 in a serpentine formation with U-shaped bends as required by claim 1 and the radius of curvature required by claim 6 (Ans. 5; Br and Reply Br., generally; Ansuini, col. 4, ll. 51-66)). The tracks are connected to individual terminals (terminals 62 and 70 for track 66 and terminals 82 and 90 for track 86) (Fig. 2; col. 4, ll. 51-66).

(Decision 7.)

Appellants contend that our use of the plural term “corrosive tracks 66 and 86” in FF 8 is incorrect and that they, in fact, did dispute that Ansuini teaches corrosive tracks 66 and 86 (Request 2-3). Appellants now argue that track 86 is not a corrosive track (Request 2).

We are not persuaded of error. What Appellants specifically argued is that

while Ansuini teaches “bends”, it teaches only a single track between a pair of two terminals (either single track 66 between terminals 62 and 70 or track 86 between terminals 82 and 90) and thus fails to teach the claimed “plurality of corrosive tracks . . . mutually inverted generally U-shaped bends” which connect two terminals.

(Br. 8; *see also* Reply Br. 4-5.) Appellants did not argue, as they do now, that track 86 is not a corrosive track. Just as we state in FF 8, the Examiner made the finding that Ansuini discloses corrosive “tracks”, and Appellants did not dispute it (*Compare* Ans. 5 with Br. 8 and Reply Br. 4-5). Therefore, our statement in the Decision was not in error. Moreover, even if track 86 is not a “corrosive” track in the preferred embodiment, there is no dispute that Ansuini teaches a U-shaped corrosive track 66 connecting two terminals.

With regard to their “teaching away” argument, most of Appellants’ contentions focus on the individual teachings of the references without appropriately considering obvious variations within the ordinary skill of the artisan. As we stated in the opinion, “a prior art reference must be ‘considered together with the knowledge of one of ordinary skill in the pertinent art.’” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (quoting *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)). We add that in an obviousness analysis, the proper focus is on evidence of what was known before the time of invention, and the analysis must not unduly constrain the breath of knowledge available to one of ordinary skill in the art. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1260 (Fed. Cir. 2007). An improvement in the art is obvious if “it is likely the product not of innovation but of ordinary skill and common sense.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

“What the prior art teaches and whether it teaches toward or away from the claimed invention . . . is a determination of fact.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995) (citing *In re Bell*, 991 F.2d 781, 784 (Fed. Cir. 1993)).

Here, we have a situation in which one reference (Kim) teaches an electric resistance sensor including a plurality of corrosive tracks (lines 41) between two terminals, and another reference (Ansuini) teaches an electric resistance sensor including a U-shaped track (at least track 66) between two terminals. Appellants have not provided persuasive evidence indicating that either reference discourages, discredits, or otherwise teaches away from using the U-shaped track of Ansuini in a sensor with multiple lines between the terminals such as the sensor of Kim. Kim merely depicts straight tracks without saying anything about the track pattern. Ansuini's U-shaped track is a single track, but nothing in Ansuini indicates that such a serpentine track cannot be used in an electric resistance sensor including a plurality of tracks between two terminals.

We cannot agree with Appellants that the mere depiction of straight tracks in Kim or the mere disclosure in Ansuini of using a single U-shaped track are the types of teachings that would discourage the ordinary artisan from making the combination. The types of teachings that “teach away” in the context of nonobviousness are teachings that criticize, discredit, or otherwise discourage the solution claimed or would produce an inoperable result when applied in the proposed prior art combination and Appellants point to no such disclosures in Kim or Ansuini. *See United States v. Adams*, 383 U.S. 39, 52 (1966) (“known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness”); *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (prior art teaching alternatives did not “teach away” because such disclosure did not criticize, discredit, or otherwise discourage the solution claimed); *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354

(Fed. Cir. 2001) (references “teach away” from the combination when the combination would produce a seemingly inoperative device).

We have weighed the evidence as a whole as is required, *see In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (teaching away is a significant factor, but the nature of the teaching is highly relevant, and must be weighed in substance), and we remain convinced that the evidence as a whole supports the conclusion of the Examiner.

With regard to the “space saving” teaching of Ansuini, Appellants argue that using the serpentine paths of Ansuini in the sensor of Kim would not save space based on the very specific detailed embodiment of Ansuini (Request 9-10). As a first matter, such an argument was not made in the briefs and, therefore, it would not be appropriate for us to consider it at this late date. *See* 37 C.F.R. § 41.52 (Except for some specific exceptions, arguments not raised in the briefs are not permitted in the request). As a second matter, Appellants are again viewing the prior art only in its most concrete terms without considering obvious variations based on the ordinary skill of the artisan.

CONCLUSION

Appellants have not convinced us of any error in our Decision.
Appellants’ Request for rehearing is denied.

DENIED

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203